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IOS 99-105

IN THE UNITED STATES PATENT AND  
TRADEMARK OFFICE

In re the Application of: Robert A.  
Lieberman, et al.

Application No.: 09-730,158

For: Distributed Optical Fiber Sensor  
with Controlled Response

Examiner: Jon Henry

Art Unit: 2872

I hereby certify that this  
correspondence is being deposited  
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Patents, Washington, DC 20231, on  
June 4, 2002.

Lawrence S. Cohen

TECHNOLOGY CENTER 8800  
JUN 18 2002

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#9  
Response  
Remilla  
6/27/02

**SUPPLEMENTAL RESPONSE TO OFFICE ACTION DATED 05/09/2002**

This is an additional response to the Office Action dated May 9, 2002. It is considered that no extension or fee is required for this response because the prior response was a good faith attempt at a complete response, and in applicant's view was complete given the articulation of the Office Action. But, if an extension of time is required for this response such extension is requested, and any fee may be charged to deposit account number 50-1054.

It is requested that the file be corrected to show that the prior submission, referred to in the Office Action should be considered as filed not on April 10, 2002, but on April 8, 2002 because it was sent with a certificate of mailing by first class mail on April 8, 2002.

In response to the Examiner's requirement.

The telephone conversation on 15 May 2002 with Examiner Henry is appreciated as the requirement is now better understood, in particular that rather than the requirement to elect a single disclosed species of those delineated, the requirement is to select a species of the group of species (a)-(e); and of the group (v), (s) and of the group (x), (y).

This is in counsel's experience a unique position. Normally, the Examiner specifies which claims he understands as falling in each species. This is only common sense since the Examiner has defined the species based on his perception of the invention as claimed. The applicant should not be left to guess

what the Examiner means. The invention is defined by the claims. Also, it is noted that the requirement states "Applicant is required...to elect a single disclosed species..." The prior election complied with this articulation. The Examiner also requires that the claims falling in the selected species as a whole be identified.

The requirement is traversed in that the species as defined by the Examiner are not mutually exclusive and therefore it is not possible to select one of the options while excluding the others.

Also, the defined species do not allow selection from all of the claims. For example claim 18 refers to a parameter as defined in claim 17, which comprises an inverse in diameter of the core from the input end to the output end.

While species (a) and (b) and (d) might comprehend this, there is no direct choice of such a parameter. So, it is not seen how applicants can elect claim 17 from the choices defined by the Examiner.

For these reasons, in the telephone interview, counsel asked the Examiner to identify the claims that go with each species; but the Examiner stated that his job is to define "inventions" not claims. However applicant does not agree with this as the requirement in paragraph 1 expressly refers to "claims"; and generic claims are specified in paragraph 2. The examination of the application is of invention as defined in the claims. See 35 U.S.C. 112 (b) - "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention"; and 37 C.F.R. 1.104 "The examination shall be complete with respect to the patentability of the invention as claimed..." See also 37 C.F.R. 1.104(b), (c), and (d).

Therefore it is clear that the species of invention in an application are those that are defined by the claims. Clearly the Examiner is trying to define the claims that will be examined.

In an effort to meet the Examiner's requirement as best it is understood, while still being allowed to prosecute the invention through claims that the applicant selects from those pending, the following election is made:

(e), (r) and (y) comprising claims 1, 2, 6, 7, 8, 17, 18, 19, 21, 22, 23, 25, 26, 27.

The basis for this election as applied to the criteria set out by the Examiner is:

1. Generic
2. Combination plus core plus chemical
6. Combination generically

- 7. Combination generically
- 8. Combination generically
- 17. Generic
- 18. Generic
- 19. Combination generically
- 21. Generic
- 22. Generic
- 23. Combination generically
- 25. Combination generically
- 26. Generic
- 27. Generic

Excluding the claims already determined by the Examiner to be generic, therefore, this election is claims 2, 6, 7, 8, 18, 19, 22, 23, 25, 26 and 27.

Respectfully Submitted,



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4 June, 2002

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